



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/914,789	08/20/1997	CHARLES B. KATZ	C0464.097255	9133

27510 7590 09/22/2004
KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
WASHINGTON, DC 20005

EXAMINER

WASYLCHAK, STEVEN R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/914,789

Applicant(s)

KATZ ET AL. *ST*

Examiner

Steven R. Wasylchak

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4,6-10 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4,6-10 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on June 23, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-4, 6-10 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al.(US 5,813,009) and in view of the article by Joseph Radigan "The Nuts and Bolts of Toeing the Line".

CLAIMS:

2. The method according to claim 23, further comprising:

transmitting said reports to at least one regulator of the financial institution./ refer to claim 23

3. The method according to claim 2, wherein the transmitting of said reports

further comprises transmitting the reports on a predetermined date to the at least one regulator./ refer to claim 23

4. Johnson does not explicitly disclose said regulators include the OCC,

FRS, FDIC, and OTS. Radigan discloses OCC, FRS, FDIC/ page 2. Radigan does not explicitly disclose OTS. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of conforming to statutory reporting requirements and auditing by financial institutions.

6. The method according to claim 23, wherein the extracting is performed on

a regular basis./ abstract; col 1, L15-17, 25-35; col 25, L 34-50

7. Neither Johnson nor Radigan explicitly disclose regular basis is a monthly

basis. Official notice is taken that this feature is old and well known in the reporting art as accounting books are closed monthly. It would have been this feature for the advantage of meeting monthly or quarterly or yearly reporting requirements.

8. The method of claim 23, wherein said plurality of sources includes branches of the financial institution./fig 7 (branch location)

9. The method according to claim 8, wherein said plurality of sources includes at least one from the group of bankcard processing centers, student loan processing centers, business loan processing centers, and US territorial locations of the financial institution./ col 6, L 15-20

10. The method according to claim 23, wherein said reports include reports required by federal regulators under the fair lending laws./ refer to claim 23

23. A computer implemented method of storing and compiling data for analysis and reporting regarding a financial institution's compliance with fair lending laws, said method comprising: Johnson discloses extracting first data from a first source wherein the first data is configured in a first format;/Johnson: abstract; col 4, L 6-13, 29-34; col 6, L 1-51; col 7, L 62 to col 8, L 26. However, Johnson does not disclose financial institution's compliance with fair lending laws. Radigan discloses financial institution's compliance with fair lending laws. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of conforming to statutory reporting requirements by financial institutions.

Art Unit: 3624

Johnson discloses multiple formats /col 2, L 37-40 (cross-platform data); col 4, L 29-34; col 6, L 1-6, 47-51. Johnson does not explicitly disclose extracting second data from a second source wherein the second data is configured in a second format. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of ultimately conforming to statutory reporting and auditing requirements by financial institutions by a sequential 1:1 mapping of data and source.

Johnson discloses a universal format/ col 16, L 31-64: "standard" as universal. However, Johnson does not specifically disclose reformatting the first data into third data. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of conforming to statutory reporting requirements by financial institutions. Reformatting is mere multiplicity of a given step of formatting.

Johnson discloses a universal format/ col 16, L 31-64: "standard" as universal. However, Johnson does not specifically disclose reformatting the second data into fourth data. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of conforming to statutory reporting requirements by financial institutions. Reformatting is mere multiplicity of a given step of formatting.

Johnson discloses normalizing data./ col 6, L 7-44; col 7, L 32-55. However, Johnson does not explicitly disclose the third and fourth data into normalized data. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of conforming to statutory reporting requirements by financial institutions. Normalizing various data points is mere multiplicity of a given step of normalizing various data for subsequent convenient analysis of data.

Art Unit: 3624

Johnson discloses parsing and normalizing/col 11, L59-63; col 9, L 54-65; col 7, L 32-55. Johnson does not disclose a first portion of the normalized data so as to form parsed data. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of conforming to statutory reporting requirements by financial institutions. Parsed data results from partitioning any part of data.

Johnson discloses normalized data and parsed data./ col 11, L59-63; col 7, L 32-55. Johnson does not explicitly disclose geo-coded data. Radigan discloses geo-coded data/page 1. Neither explicitly disclose a second portion of the normalized data and the parsed data so as to form geo-coded data. It would have been obvious to one advantage of conforming to statutory reporting requirements by financial institutions with branches.

Johnson discloses storing normalized data/ col 7, L 1-55. Johnson does not explicitly disclose storing a third portion of the normalized data so as to form currently stored normalized data. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of conforming to statutory reporting requirements and auditing by financial institutions.

Johnson does not explicitly disclose storing the geo-coded data so as to form currently stored geo-coded data. Radigan discloses storing the geo-coded data so as to form currently stored geo-coded data./page 1. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to

use this limitation for the advantage of conforming to statutory reporting requirements and auditing by financial institutions and branches.

determining if the currently stored normalized data differs from previously stored normalized data or if the currently stored geo-coded data differs from previously stored geo-coded data;/ abstract; fig 1B; fig 3(archive); col 9, L66 to col 10, L 11 (redundancy as non-difference).

integrating the currently stored normalized data with the previously stored normalized data so as to form integrated normalized data if the currently stored normalized data differs from the previously stored normalized data;/col 1, L 62 to col 2, L15; col 16,L 31-64; col 26, L 34-45

integrating the currently stored geo-coded data with the previously stored geo-coded data so as to form integrated geo-coded data if the currently stored geo-coded data differs from the previously stored geo-coded data;/ col 1, L 62 to col 2, L15; col 16, L 31-64; col 26, L 34-45

preparing reports from either a combination of the integrated normalized data and integrated geo-coded data or from a combination of currently stored normalized data and currently stored geo-coded data/ col 16, L 31-64; col 26, L 34-45

Art Unit: 3624

This action is **NON-FINAL**. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R. Wasylchak whose telephone number is (703) 308-2848. The examiner can normally be reached on Monday-Thursday from 7:00 a.m. to 6:00 p.m. EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065. The fax number for Art Unit 3624 is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Steven Wasylchak

9/18/04



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Notice of References Cited

Application/Control No.

08/914,789

Applicant(s)/Patent Under
Reexamination
KATZ ET AL.

Examiner

Steven R. Wasylchak

Art Unit

3624

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,813,009	09-1998	Johnson et al.	707/100
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Joseph Radigan. The Nuts and Bolts of Toeing the Line. The United States Banker. Vol.104 n10. Pages 48-49. Oct. 1994.
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.